

LAHIVE & COCKFIELD LLP

COUNSELLORS AT LAW
28 STATE STREET
BOSTON, MASSACHUSETTS 02109-1784
TELEPHONE (617) 227-7400
FAX (617) 742-4214
lc@lahive.com

JOHN A. LAHIVE, JR. (1928-1997)
THOMAS V. SMURZYNSKI
RALPH A. LOREN
GIULIO A. DECONTI, JR.
ANN LAMPORT HAMMITT
ELIZABETH A. HANLEY
AMY BAKER MANDRAGOURAS
ANTHONY A. LAURENTANO
KEVIN J. CANNING
JANE E. REMILLARD
DEANN FORAN SMITH
PETER C. LAURO
JEANNE M. DIGIOKOIO
DEBRA J. MILASINIC, Ph.D.
DAVID J. RUKERS
DAVID R. BURIN
JOHN S. CURRAN
SEAN D. DETWILER

CYNTHIA L. KANDL, Ph.D.
MEGAN E. WILLIAMS, Ph.D.
RICHANAND
MICHAEL PHILLIPPS *
LISA M. DIROCCO
HATHAWAY P. RUSSELL **
MARIA LACCOTRIPE ZACHARAKIS, Ph.D.
PETER A. DIMATTIA
VINCENT P. LOCCESANO
MEREDITH C. ARNOLD

SENIOR COUNSEL
JAMES E. COCKFIELD

OF COUNSEL
JEREMIAH LYNCH
WILLIAM A. SCOFIELD, JR.
SHLEY P. REPPERT

PATENT AGENTS
THEODORE R. WEST
SHAYNE Y. HUFF, Ph.D.
DANIEL B. KO

TECHNICAL SPECIALISTS
CYNTHIA M. SOROOS
PETER W. DINI, Ph.D.
SUHOON LEE
JENNIFER K. ROSENFELD
ALLAN TAMPSHTIT, Ph.D.
CATHERINE E. MCFHERSON
ERIC F. WAGNER, Ph.D.
SHAHID HASAN, Ph.D.
JACOB O. WEINTRAUB
JONATHAN M. SPARKS, Ph.D.
CHRISTIN E. HOWLEY, Ph.D.

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AUG 06 2002

GROUP 1600

Facsimile Cover Sheet

To: Examiner Samuel W. Liu
Company: U.S. Patent and Trademark Office
Location: Washington, D.C.
Phone: 703-306-3483
Fax: 703-308-4242

From: Maria C. Laccotripe
Phone: (617) 227-7400
Fax: (617) 742-4214
Case No.: AHN-001DV2
USSN 09/658,969

Date: August 5, 2002
Sent By: MCL/kat
Pages including this cover page: 9

Message: Please ENTER AND DELIVER to Examiner Samuel W. Liu
At Group Art Unit 1653.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: Winfried Edelmann *et al.*

Serial No.: 09/658,969

Filed: September 11, 2000

For: *METHODS FOR MODULATING THE
ACTIVITY OF MSH5 (as Amended)*

Attorney Docket No.: AHN-001DV2

Group Art Unit: 1653

Examiner: Samuel W. Liu

Commissioner for Patents
Washington, D.C. 20231

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to Commissioner for Patents,
Washington, D.C. 20231 on the date set forth below.August 5, 2002

Date of Signature and of Mail Deposit

By: 

Marla C. Laccotripe, Ph.D.

Limited Recognition Under 37 C.F.R. § 10.9(b)
Attorney for ApplicantsRESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the restriction requirement set forth in the Office Action dated June 4, 2002 (Paper No. 11). A separate petition for the appropriate extension of time in which to respond is being filed concurrently herewith.

The Examiner has required restriction to one of the following inventions under 35 U.S.C. §121:

- I. Claim 24, drawn to a polynucleotide, classified in class 536, subclass 23.1.
- II. Claim 25, drawn to small molecules that are of non-organic and non-peptide and characteristics, classified in class 260.
- III. Claim 26, drawn to antibody specifically recognizes and binds MSH5, classified in class 530, subclass 387.1.

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- IV. Claim 27, drawn to polypeptide, classified in class 435, subclass 350, and class 514, subclass 2.
- V. Claim 28, drawn to peptidomimetic substance which is not a polypeptide or peptide, classified in class 564, subclass 152, class 514, subclass 23 and 54.
- VI. Claim 29, drawn to a substance having an effect on substrate for MSH5, substance can be nucleotide, classified in class 435, subclass 89⁺, or other organic compound, classified in class 552, subclass 500⁺.

Applicants hereby elect the Group II invention (claim 25) drawn to small molecules, for prosecution in this application, *with traverse*. It is Applicants' understanding that claims 15-17, 22, 23, 30 and 31 will all be examined to the extent that these claims read on the elected invention.

Applicants hereby *traverse* the foregoing Restriction Requirement on the grounds that Groups I-VI should be re-grouped as a single invention, as Groups I- VI encompass inventions which are connected in design, operation, and effect, *i.e.*, are not independent (M.P.E.P. §808.01). Applicants have presented generic claim 15 which is directed to a method for modulating MSH5 expression or activity comprising contacting MSH5 or a cell expressing MSH5 with a compound in a sufficient concentration to modulate MSH5 expression or activity. The *compound that modulates MSH5 expression or activity* can be a small molecule, a polypeptide, a peptidomimetic, an antisense nucleic acid molecule, or an anti-MSH5 antibody. These compounds have the same effect, *i.e.*, they modulate MSH5 activity, and the same design and operation. For example, a peptide, a peptidomimetic and an antibody all operate by binding to an active site on the MSH5 polypeptide, thereby modulating its activity. For the foregoing reasons, Applicants respectfully submit that a sufficient search and examination with respect to the inventions of Groups I-VI can be made without serious burden on the Examiner.

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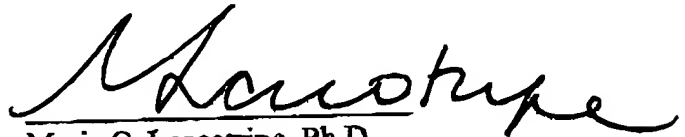
Applicants believe that a *species election*, e.g., wherein the compound is a small molecule, may be proper for searching purposes only, posing no undue burden on the Examiner. However, a restriction under 35 U.S.C. § 121 is improper for the above-stated reasons. Accordingly, Applicants hereby request that the invention of Groups I-VI be combined into a single Group.

Applicants reserve the right to traverse the restriction between the non-elected groups in this or a separate application.

SUMMARY

If a telephone conversation with Applicants' Attorney would expedite the prosecution of the above-identified application, the Examiner is urged to call Applicants' Attorney at (617) 227-7400.

Respectfully submitted,



Maria C. Laccotripe, Ph.D.
Attorney for Applicants
Limited Recognition Under 37 C.F.R. § 10.9(b)

LAHIVE & COCKFIELD, LLP
28 State Street
Boston, MA 02109
Tel. (617) 227-7400

Dated: August 5, 2002

**BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE
UNITED STATE PATENT AND TRADEMARK OFFICE**

LIMITED RECOGNITION UNDER 37 CFR § 10.9(b)

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Expires: September 4, 2002



Harry L. Montz

Director of Enrollment and Discipline